

REMARKS

As for the status of the application, Claims 1 and 6 have been amended and Claims 1-11 are pending in this application. Reconsideration of this application is respectfully requested. A petition and fee for a one month extension of time is enclosed.

The drawings were objected to under 37 CFR 1.83(a) because they fail to show "customizable share system 40" as described in the specification. Fig. 1a has been amended to add reference numeral 40 and associated arrow to the figure. The drawings were also objected to as failing to comply with 37 CFR 1.84(p)(5) because they include reference character 47 not mentioned in the description. Reference character 47 has been deleted from Fig. 1a. Enclosed is an amended drawing figure having proposed amendments marked in red ink. Also enclosed is a replacement reproducing master containing the amendments. It is respectfully submitted that the enclosed replacement reproducing master complies with 37 CFR 1.83(a). Withdrawal of the Examiner's objection is respectfully requested.

Claims 6-11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner noted an antecedent basis issue in Claim 6. Claim 6 has been amended to address the antecedent basis issue. It is respectfully submitted that Claim 6 is now clear and definite. Withdrawal of the Examiner's rejection is respectfully requested.

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,829,009 B2 issued to Sugimoto in view of U.S. Patent No. 6,784,924, B2 issued to Ward et al. The Examiner's position is that "Sugimoto teaches, in column 3, lines 30-35 and 44-50, a digital camera comprising a display for allowing user selection of options from a menu. Sugimoto further teaches, in column 7, lines 10-20, the automatic customization of the menu. Sugimoto further teaches, in column 6, lines 6-25 and figure 5, user selectable menu options where menu options have sub-menu options further selectable by the user.

The Examiner admitted that "Sugimoto, however, doesn't list menu options initiating a connection with an external device." However, the Examiner cited the Ward patent as teaching "a digital camera with a LCD for selecting menu options from a custom subset of a menu (see column 3, lines 15-26), similar to that of Sugimoto, but further teaches the camera being in communication with a external device and selecting a menu option to initiate a connection with the external device, for performing a selected action (see column-1, lines 57-62 and column 3, lines 14-39)."

Claim 1 calls for:

"a customizable menu that is displayable on the display and which comprises a plurality of customizable and selectable user interface items that respectively correspond to selected tasks or actions that may be performed by a user, each user interface item having one or more subtasks or sub-actions associated therewith, which tasks/actions and subtasks/sub-actions are selectable by the user and which initiates a through connection with the external device, and causes the selected task or action to be performed on the external device in a preprogrammed manner."

It is respectfully submitted that the Sugimoto patent does not disclose or suggest anything regarding connecting the camera to an external device, as was admitted by the Examiner. Therefore, it is respectfully submitted that modifying the Sugimoto camera to provide for such a connection distorts the express teachings or the Sugimoto patent beyond its intended scope.

Furthermore, and contrary to the assertion of the Examiner, the Ward et al. patent does not disclose or suggest that the camera is connected to an external device and performs a selected action on the external device. The Examiner has misconstrued the express teachings of the Ward et al. patent.

What is stated at column 3, lines 14-39 of the Ward et al. patent is that

"The steps used to automatically transmit images using the network configuration file are shown in FIG. 2. After disconnecting the camera from the host PC, the user operates the camera to take pictures (step 50). This is typically done at a remote location, for example while traveling to another city. As the user takes or reviews images on the image LCD display, the decision can be made to transmit one or more images (step 52). This is done by choosing one of the keywords or icons in a menu 54 shown in FIG. 2, which are displayed on the LCD 24 and selected, e.g., through the user buttons 26. (Note that a camera will typically only include a subset (only those desired by the user) of all the different services shown.) The selected image files may be tagged with a code (step 56) indicating which service is requested, as shown in FIG. 3. (Alternately, an "image utilization" file can be created in the camera storing a list of images to be transmitted by a particular method, as described in the cross-referenced copending patent application (U.S. Serial No. 60/037,963). As described in that patent application, the details of an order, e.g., number of print copies to be made from an image and the size of the prints and/or a list of images to be e-mailed to various recipients, is written into the "utilization" file, which identifies the order and includes pointers to the image files that store the images required to "fulfill" the order. The "utilization" file is stored in the internal memory 28 or the memory card 30.)"

Nothing is stated in this portion of the Ward et al. patent that indicates that any action is performed on the external device. All that is stated is that the user may transmit images from the camera.

With regard to the first paragraph of the Summary of the Invention section of the Ward et al. patent, which includes column 1, lines 57-62, it is stated that

"The present invention is directed to overcoming one or more of the problems set forth above. Briefly summarized, according to one aspect of the present invention, a network configuration file is generated at a host computer and downloaded to a digital camera. This file contains instruction information for communicating with a selected destination via a communications interface. The digital camera includes a "send" button or LCD icon which allows the user to easily transmit one or more images via a wired or wireless communications interface to a desired destination, which among other possibilities may be an Internet Service Provider or a digital photofinishing center. When the user selects this option, the communications port settings, user account specifics, and destination connection commands are read from the network configuration file. Examples of these settings include serial port baud rate, parity, and stop bits, as well as account name and password."

It is respectfully submitted that the settings that are read from the network configuration file do not contain any commands that cause a selected task or action to be performed on an

external device in a preprogrammed manner" as is presently claimed. The serial port baud rate, parity, and stop bits, account name and password transmitted from the camera do not cause a selected task or action to be performed on an external device in a preprogrammed manner. All these actions do is allow communication between the camera and the external device.

With further regard to column 3, lines 14-39 of the Ward et al. patent, while it is stated that an "image utilization" file can be created in the camera, it is respectfully submitted that this file does not cause a selected task or action to be performed on an external device in a preprogrammed manner. The image utilization file contains "details of an order, e.g., number of print copies to be made from an image and the size of the prints and/or a list of images to be e-mailed to various recipients, is written into the "utilization" file, which identifies the order and includes pointers to the image files that store the images required to "fulfill" the order."

While, for example, the file may contain the number of print copies to be made from an image, this tells a person operating a printing machine how many copies to print; the transmitted information does not cause an action to occur on the printing machine. Similarly, if a list of images to be e-mailed to various recipients is included in the utilization file, this only tells the operator of the printing machine to email images to the listed recipients. The external device does not respond to the anything in the utilization file to perform an action. [Emphasis added]

It is therefore respectfully submitted that "customizable and selectable user interface items ... which initiates a through connection with the external device, and causes the selected task or action to be performed on the external device in a preprogrammed manner" are not disclosed or suggested by the Sugimoto or Ward et al. patents, taken singly or together. It is respectfully submitted that these aspects of the invention recited in Claim 1 are not derivable from the teachings of the Sugimoto or Ward et al. patents, taken singly or together absent extending the express teachings of the patents and using improper hindsight reconstruction.

One skilled in the art reading the Sugimoto patent would not be inclined to connect it to an external device. One skilled in the art reading the Ward et al. patent would not provide an image utilization file that would cause an action to be performed on an external device, as is asserted by the Examiner. The Ward et al. patent teaches that instructions may be provided to an operator of an external device, but there is no disclosure or suggestion that any action is performed by the external device in response to the instructions. Therefore, it is respectfully submitted that any attempt to combine the teachings of the Sugimoto or Ward et al. patents amounts to improper hindsight reconstruction.

In view of the above, it is respectfully submitted that independent Claim 1 is not obvious in view of the Sugimoto or Ward et al. patents, taken singly or together, and not without using improper hindsight reconstruction. Accordingly, it is respectfully submitted that Claim 1 is allowable over the cited references. Withdrawal of the Examiner's rejection and allowance of Claim 1 are respectfully requested.

Dependent Claims 2-5 are considered allowable at least based upon the allowability of independent Claim 1 from which they depend. Accordingly, it is respectfully submitted that

Claims 2-5 are allowable over the cited references, taken singly or together. Withdrawal of the Examiner's rejection and allowance of Claims 2-5 are respectfully requested.

With regard to Claim 6, it is respectfully submitted that the arguments presented above with regard to Claim 1 support the allowability of Claim 6. Neither the Sugimoto or Ward et al. patents, taken singly or together, disclose or suggest "programming the system to have a customizable menu that is displayable on the display and which comprises a plurality of customizable and selectable user interface items that respectively correspond to selected tasks or actions that may be performed by a user, each user interface item selectively having one or more subtasks or sub-actions associated therewith" and "initiating a through connection with the external device to cause the selected task or action to be performed on the external device in a preprogrammed manner."

In view of the above, it is respectfully submitted that independent Claim 6 is not obvious in view of the Sugimoto or Ward et al. patents, taken singly or together, and not without using improper hindsight reconstruction. Accordingly, it is respectfully submitted that Claim 6 is allowable over the cited references. Withdrawal of the Examiner's rejection and allowance of Claim 1 are respectfully requested.

Dependent Claims 7-11 are considered allowable at least based upon the allowability of independent Claim 6 from which they depend. Accordingly, it is respectfully submitted that Claims 7-11 are allowable over the cited references, taken singly or together. Withdrawal of the Examiner's rejection and allowance of Claims 7-11 are respectfully requested.

The art made of record and not relied upon is considered pertinent to applicant's disclosure to the extent indicated by the Examiner.

In view of the above, it is respectfully submitted that all pending Claims are not obvious in view of the cited references, taken singly or together, and not without the use of improper hindsight reconstruction, and are therefore patentable. Therefore, it is respectfully submitted that the present application is in condition for allowance. Reconsideration and allowance of this application are earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Kenneth W. Float', with a stylized, overlapping flourish at the end.

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